

## REMARKS

Claims 1-41 are pending in the application. Claims 1-10, 29-31, 36 and 37 were rejected. Claims 1, 2, 4-7, and 29-31 are herein amended. Claims 3, 9, 11-28, 32-35, and 38-41 are herein canceled, without prejudice or disclaimer. Applicants request reconsideration in light of the amendments and following remarks.

### Summary of Rejections

- Claims 1-4, 7, 8, and 9 were rejected under 35 U.S.C. §102(b) over Naito et al. (U.S. 6,628,417).
- Claims 29, 31, and 36 were rejected under 35 U.S.C. §102(b) over Salgado et al. (U.S. 5,970,224).
- Claims 5, 6 and 10 were rejected under 35 U.S.C. §103(a) over Naito et al. in view of Goldberg et al. (U.S. 6,762,855).
- Claims 30 and 37 were rejected under 35 U.S.C. §103(a) over Salgado et al. in view of Goldberg et al.

### Claim Amendments

Applicants are herein amending claim 1 to incorporate the subject matter of claim 3, and canceling claim 3, without prejudice or disclaimer. No new matter has been introduced by the amendment of claim 1. Support for the amendment may be found, inter alia, in original claim 3 and in the specification, para. [0015].

Applicants are herein amending claims 2 and 4 to correct claim dependency as a result of the amendment of claim 1. No new matter has been added.

Applicants are herein amending claim 6 to clarify aspects of the claim. No new matter has been introduced by the amendment of claim 6. Support for the amendment may be found in the specification, para. [0015], inter alia.

Applicants are herein amending claim 7 to incorporate the subject matter of claim 9, and canceling claim 9, without prejudice or disclaimer. No new matter has been introduced by the amendment of claim 7. Support for the amendment may be found, inter alia, in original claim 9 and in the specification, para. [0015].

Applicants are also amending claims 1, 2, 4-6, 29, 30 and 31 to remove the alphanumeric characters from the method steps. No new matter has been added.

Applicants are herein canceling claims 3, 9, 11-28, 32-35, and 38-41, without prejudice or disclaimer. Applicants explicitly reserve the right to file one or more continuing or other applications to the non-elected and canceled subject matter.

Claim Rejections under 35 U.S.C. §102(b)

*Claims 1-4, and 7-9*

Claims 1-4, 7, 8, and 9 were rejected under 35 U.S.C. §102(b) over Naito et al. Applicants traverse the rejection. Furthermore, Applicants do not concede the merits of the rejection, but nevertheless have amended claim 1 to further clarify Applicant's techniques.

As amended, claim 1 and its dependent claims recite estimating amounts of time required to perform image processing on each of the plurality of digital images; selecting an order in which to perform image processing on at least some of the plurality of digital images based on the estimates made; and performing image processing on at least some of the plurality of digital images in the order selected to produce a plurality of processed images. Naito et al. discloses an order ID that combines the user ID of the user who placed the print order, an identifier (IP address upon connecting [to] the network) of a client computer from which the user placed the order, and the time the order was placed. Column, 21, lines 1-4. However, Naito et al. fails to disclose at least estimating amounts of time required to perform image processing on each of the plurality of digital images. Accordingly, the Section 102 rejection of claim 1 and its dependent claims, as amended, should be withdrawn.

Amended claim 1 and its dependent claims also recite storing the plurality of digital images in the RAMdisk in the order in which the plurality of digital images are to be printed, and retrieving the plurality of digital images from the RAMdisk in the order in which the plurality of digital images are to be printed. Naito et al. also fails to disclose digital images being stored on a RAMdisk. Instead, Naito et al. discloses images and the like are stored onto the RAM via a FDD. Column 32, lines 9-11. Naito discloses that RAM is used as a main memory of the CPU (from where the images and the like are viewed – column 4, lines 28-30) , and serves as areas for an OS and execution program, and an execution area and data area of the program during operation. Column 5, lines 15-19; Column 6, lines 18-22. However, RAMdisk is a software abstraction that treats a segment of random access memory (RAM) as secondary storage, a role typically filled by hard drives. Applicants contend that it is insufficient to presume that the RAM of Naito et al. corresponds to the RAMdisk of claim 1 because the RAMdisk is a portion of RAM and performs a function completely different from that of RAM. Accordingly, the Section 102 rejection of claim 1 and its dependent claims is improper.

As amended, claim 7 and its dependent claims recite a means for estimating amounts of time required to perform image processing on each of the plurality of digital images; a means for selecting an order in which to perform image processing on at least some of the plurality of digital images based on the estimates made; and means for performing image processing on at least some of the plurality of digital images in the order selected to produce a plurality of processed images. Naito et al. discloses an order ID that combines the user ID of the user who placed the print order, an identifier (IP address upon connecting the network) of a client computer from which the user placed the order, and the time the order was placed. Column 21, lines 1-4. However, Naito et al. fails to disclose a means for estimating amounts of time required to perform image processing on each of the plurality of digital images. Accordingly, the Section 102 rejection of claim 7, as amended, should be withdrawn.

As amended, claim 7 and its dependent claims recite storing the plurality of digital images in the RAMdisk in the order in which the plurality of digital images are to be printed, and a means for retrieving the plurality of digital images from the RAMdisk in the order in which the

plurality of digital images are to be printed. Naito et al. fails to disclose a means for storing the plurality of digital images in the order in which they are to be printed and a means for retrieving the plurality of digital images in the order in which they are to be printed. As noted above, Naito et al. also fails to disclose digital images being stored on a RAMdisk and retrieving the digital images from the RAMdisk. Instead, Naito et al. discloses images and the like are stored onto the RAM via a FDD. Column 32, lines 9-11. Naito et al. discloses that RAM is used as a main memory of the CPU (from where the images and the like are viewed – column 4, lines 28-30), and serves as areas for an OS and execution program, and an execution area and data area of the program during operation. Column 5, lines 15-19; Column 6, lines 18-22. However, RAMdisk is a software abstraction that treats a segment of random access memory (RAM), as secondary storage a role typically filled by hard drives. Applicants contend that it is insufficient to presume that the RAM of Naito et al. corresponds to the RAMdisk of claim 7 because the RAMdisk is a portion of RAM and performs a function completely different from that of RAM. Accordingly, the Section 102 rejection of claim 7 and its dependent claims is improper.

Specifically regarding claim 8, in the rejection, the Examiner stated that “the retrieval means” of claim 8 corresponds to the element represented by reference numeral 3902 of FIG. 39. The Applicant contends that reference numeral 3902 is a printer type field in a basic fee table 3910 which manages image date use fees of pay images. Accordingly, the Section 102 rejection of claim 8 is improper.

In view of the foregoing arguments, Applicant submits that the Office has failed to establish a proper anticipation rejection, and therefore, requests the Office to withdraw the rejection of claims 1-4, 7, 8 and 9 under 35 U.S.C. §102(b) as being anticipated by Naito et al.

*Claim 29, 31 and 36*

Claims 29, 31 and 36 were rejected under 35 U.S.C. §102(b) over Salgado et al. Applicants traverse the rejections and request reconsideration thereof.

Claim 36 is drawn to a system for printing a plurality of digital images. Regarding claim 36, the Office states that Salgado et al. discloses a print engine activation means. The Applicant contends that video control module 16 (VCM) does not activate the print engine. Instead, Salgado et al. discloses that the VCM coordinates the scanner and printer in a digital copying arrangement. Specification, column 5, lines 64-67. Accordingly, the anticipation rejection of claim 36 is improper .

Claim 29 is drawn to a computer-implemented method for printing a plurality of digital images. The Office states that claim 29 is rejected for the same reasons as claim 36. The Applicant again contends that the VCM does not activate the print engine. Instead, Naito et al. discloses that the VCM coordinates the scanner and printer in a digital copying arrangement. Specification, column 5, lines 64-67. Accordingly, the Section 102 rejection of claim 29 is improper .

Regarding claim 31, the Office alleges that step (A) is performed by a Network Service Module. The Applicant disagrees with the Office's allegation because Salgado et al. fails to disclose that the Network Service Module performs image processing on a first set of images including fewer than all of the digital images to produce a first plurality of processed images. Accordingly, the Section 102 rejection of claim 31 is improper.

In view of the foregoing arguments, Applicant submits that the Office has failed to establish a proper Section 102 rejection, and therefore, requests the Office to withdraw the rejection of claims 29, 31 and 36 under 35 U.S.C. §102(b) as being anticipated by Salgado et al.

#### Claim Rejections under 35 U.S.C. §103(a)

##### *Claim 6*

Claim 6 was rejected under 35 U.S.C. §103(a) over Naito et al. in view of Goldberg et al. Applicants traverse the rejection. Moreover, Applicants do not concede the merits of the rejection, but nevertheless have amended claim 6 to further clarify Applicant's techniques.

As amended, claim 6 recites estimating amounts of time required to perform image processing on each of the plurality of digital images; selecting an order in which to perform image processing on at least some of the plurality of digital images based on the estimates made; and performing image processing on at least some of the plurality of digital images in the order selected to produce a plurality of processed images. Naito et al. discloses an order ID that combines the user ID of the user who placed the print order, an identifier (IP address upon connecting the network) of a client computer from which the user placed the order, and the time the order was placed. Column 21, lines 1-4. However, Naito et al. fails to disclose at least estimating amounts of time required to perform image processing on each of the plurality of digital images.

The Office acknowledges on page 11 of the Office Action that Naito et al. does not explicitly teach at the print server, printing the plurality of digital images on output media using a print engine without stopping and restarting the print engine. The Office asserts that Goldberg discloses this missing feature. However, because Naito et al. fails to disclose estimating amounts of time required to perform image processing on each of the plurality of digital images and because Goldberg does not disclose such an element, Naito et al., alone or in combination with Goldberg, fail to teach all the elements of claim 6. Accordingly, the rejection of claim 6 should be withdrawn.

The Applicants also contend that Naito et al. fails to disclose digital images being stored on a RAMdisk and retrieving the digital images from the RAMdisk. Instead, Naito et al. discloses images and the like are stored onto the RAM via a FDD. Column 32, lines 9-11. Naito et al. discloses that RAM is used as a main memory of the CPU (from where the images and the like are viewed – column 4, lines 28-30), and serves as areas for an OS and execution program, and an execution area and data area of the program during operation. Column 5, lines 15-19; Column 6, lines 18-22. However, RAMdisk is a software abstraction that treats a segment of random access memory (RAM), as secondary storage a role typically filled by hard drives. Applicants contend that it is insufficient to presume that the RAM of Naito et al. corresponds to the RAMdisk of claim 6 because the RAMdisk is a portion of RAM and performs

a function completely different from that of RAM. Goldberg also fails to disclose digital images being stored on a RAMdisk and retrieving the digital images from the RAMdisk. Accordingly, the obviousness rejection claim 6 is improper.

Applicants submit that it has not been established in the Office Action that the claim is *prima facie* obvious. To establish a proper *prima facie* rejection, the following elements must be shown:

- (1) the reference(s) is (are) available as prior art against the claimed invention;
- (2) the motivation (explicit or implicit) provided by the reference(s), common sense, or common knowledge that would have rendered the claimed invention obvious to one of ordinary skill in the art at the time of the invention;
- (3) a reasonable expectation of success;
- (4) the basis for concluding that the claimed invention would have been obvious to do; and
- (5) the reference(s) teach(es) the claimed invention as a whole.

*KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007).

Applicant submits that all of the above elements have not been established. Hence, a *prima facie* obviousness rejection is improper.

Thus, even if Naito et al. and the Goldberg were properly combinable, and applicants are not conceding that it is proper to do so, the combined disclosures of Naito et al. and Goldberg would not disclose or suggest all the features of claim 6.

In view of the foregoing arguments, Applicants submit that the Office has failed to establish a proper *prima facie* obviousness rejection and, therefore, request the Office to withdraw the rejection of claim 6 as being rejected under 35 U.S.C. § 103(a), as obvious over Naito et al. in view of Goldberg.

*Claims 5 and 10*

Claims 5 and 10 were rejected under 35 U.S.C. § 103(a) over Naito et al. in view of Goldberg. Applicants respectfully traverse this ground of rejection with respect to the amended claims and requests reconsideration thereof. MPEP 2143.03 teaches “[t]o establish a prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Claim 5 depends from claim 1 and adds further elements thereto. Claim 10 depends from claim 7 and adds further elements thereto. Applicants submit that for at least the reasons stated above with respect to patentability of claims 1 and 7, Naito et al., alone or in combination with Goldberg, does not disclose, teach, or suggest estimating amounts of time *or* a means for estimating amounts of time required to perform image processing on each of the plurality of digital images; selecting an order *or* a means for selecting an order in which to perform image processing on at least some of the plurality of digital images based on the estimates made; or performing image processing *or* a means for performing image processing on at least some of the plurality of digital images in the order selected to produce a plurality of processed images. Therefore, the Applicant requests the rejection under 35 U.S.C. §103(a) be withdrawn and solicits allowance of claims 5 and 10.

*Claims 30 and 37*

Claims 30 and 37 were rejected under 35 U.S.C. § 103(a) over Salgado et al. in view of Goldberg. Applicants respectfully traverse this ground of rejection with respect to the amended claims and requests reconsideration thereof. MPEP 2143.03 teaches “[t]o establish a prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Claim 30 depends from claim 29 and adds further elements thereto. Claim 37 depends from claim 36 and adds further elements thereto. Applicants submit that for at least the reasons stated above with respect to patentability of claims 29 and 36, Salgado et al., alone or in combination with Goldberg, does not teach activating a print engine *or* a print engine activation



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means. Therefore, the Applicant requests the rejection under 35 U.S.C. §103(a) be withdrawn and solicits allowance of claims 30 and 37.

### **CONCLUSION**

In view of the foregoing remarks, Applicant respectfully submits that claims 1, 2, 4-7 and 29-31, as amended, are in condition for allowance and entry of the present amendment and notification to that effect is earnestly requested. If necessary, the Examiner is invited to telephone Applicant's attorney at the number provided to facilitate prosecution of the application.

The Commissioner is hereby authorized to charge any deficiency or credit any overpayment of the fees associated with this communication to Deposit Account No. 23-3050.

The Commissioner is hereby requested to grant an extension of time for the appropriate length of time, should one be necessary, in connection with this filing or any future filing submitted to the U.S. Patent and Trademark Office in the above-identified application during the pendency of this application. The Commissioner is further authorized to charge any fees related to any such extension of time to Deposit Account 23-3050.

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